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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,783	03/15/2004	Peter T. O'Heeron	122182.0024.000	9197
48478	7590	05/03/2006	EXAMINER	
CLARENCE EMILE ERIKSEN 3200 SOUTHWEST FREEWAY, SUITE 2355 HOUSTON, TX 77027			LIU, JONATHAN	
			ART UNIT	PAPER NUMBER
			3673	
DATE MAILED: 05/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/800,783	Applicant(s) O'HEERON ET AL.	
	Examiner Jonathan J. Liu	Art Unit 3673	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowe (US 5827228). Rowe discloses a seal which is generally cylindrical in shape and has upper and lower portion (see figure 26), the lower portion of the seal being formed for mating engagement with the access port at the proximal end of the trocar and the upper portion of the seal having a central hole (748) formed therein to permit a surgical to pass through the seal; and a plurality of folds/pleats (744) formed in the upper portion in proximity to the central hole (see figure 25).

In regards to claim 2, Rowe discloses wherein the folds comprise a plurality of substantially straight accordion-like folds, which radiate outwardly from the central hole (col. 9, lines 19-21).

With regards to claims 6 and 7, Rowe discloses the seal comprising a pliable material, more preferably, silicone (col. 9, lines 27-30).

Regarding claim 8, Rowe shows at least 2 pleats/folds (approximately 20) in the seal [see figure 25].

***Claim Rejections - 35 USC § 103***

3. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe (US 5827228) in view of Kramer et al. (US 5792113). The teachings of Rowe have been discussed above; however, Rowe fails to disclose the seal, wherein the central hole is approximately 2.0 mm in diameter, and wherein the central hole in the seal is expandable from approximately 2.0 mm to about 13 mm.

Kramer discloses a seal for installation on a trocar wherein the central hole is approximately 3 mm in diameter and capable of being expandable from about 3-12 mm in order to accommodate instruments of varying diameter (col. 4, lines 42-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the seal taught by Rowe with diameter and flexibility (i.e. expandability) as taught by Kramer in order to provide a seal for accommodating varying diameters of instruments.

***Response to Arguments***

4. Applicant's arguments filed 3/16/2006 have been fully considered but they are not persuasive. In pages 5-7 of the remarks, applicant argues the combination of a seal and trocar (i.e. one having a proximal end that has an access port); however, claim 1 positively claims only a seal. Therefore, it is maintained that the seal of Rowe is structurally capable of performing the functions recited in claim 1 when installed on a trocar. Furthermore, the recitation "for installation on a trocar, having a proximal end

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that has an access port" in claim 1 is merely intended use and not accorded any patentable weight since the structure of Rowe is clearly capable of performing the function and intended use.

5. In response to applicant's argument that the seal of Rowe is for installation *in* a trocar rather than *on* a trocar, a recitation of the intended use of the claimed invention (in this case, the seal) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Accordingly, the prior art seal structure is capable of performing the intended use, since there is no structural difference between the claimed seal and that disclosed by Rowe.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan J. Liu whose telephone number is (571) 272-8227. The examiner can normally be reached on Monday through Friday, 8 am - 5pm.

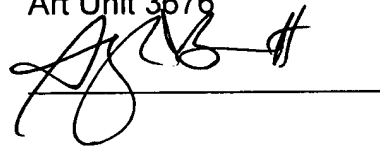
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Suzanne Barrett can be reached on (571) 272-7053. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jonathan J Liu  
Examiner  
Art Unit 3673

Suzanne Barrett  
Primary Examiner  
Art Unit 3676

A handwritten signature in black ink, appearing to read 'Suzanne Barrett', is written over a horizontal line.